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JG/R.: 08-07

Paper No: __

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SEP 04 2007

OFFICE OF PETITIONS

In re Application of
Endt
Application No. 10/785,447
Filing Date: 24 February, 2004
Attorney Docket No.: P04,0026

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DECISION

This is a decision on the petition filed on 9 November, 2006, and properly considered as a request under 37 C.F.R. §1.181 for the withdrawal of the holding of abandonment.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.¹

Petitioner's attention is drawn to the provisions of 37 C.F. R. § 1.3²

¹ **NOTE:** Monitoring of the status of applications on PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected. Status Inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.

² 37 C.F. R. § 1.3 **Business to be conducted with decorum and courtesy.**
Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be provided. Complaints against examiners and other employees must be made in correspondence separate from other papers. [Amended, 61 FR 56439, Nov. 1, 1996, effective Dec. 2, 1996; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; revised, 68 FR 38611, June 30, 2003, effective July 30, 2003] (Emphasis supplied.)

NOTE: Petitioner may wish to submit a supplemental reply to the 30 December, 2005, Notice of Non-Compliant Amendment with a statement and corrected drawing that are reflective of Petitioner's intent—whether as a “replacement,” “new” or “annotated,” or otherwise, as Petitioner appears to intend that the drawing be an exemplar for Petitioner's discussion, rather than a figure/drawing of the application *per se*—and consistent with both the 30 December, 2005, Notice of Non-Compliant Amendment and the provisions of 37 C.F. R. § 1.3.

For the reasons set forth below, the petition as considered under 37 C.F.R. § 1.181 is **GRANTED.**

BACKGROUND

The record indicates that:

- Petitioner failed to reply timely and properly to the Notice of Non-Compliant Amendment mailed on 30 December, 2005, with reply due absent extension of time on or before 30 January, 2006;
- the application went abandoned by operation of law after midnight 30 January, 2006;
- the Office mailed the Notice of Abandonment on 8 September 2006;
- on 9 November, 2006, Petitioner filed (over a 6 November, 2006, Certificate of Mailing) the instant petition, with, *inter alia*, an averment that he had replied, a copy of that reply, and a date-stamped (“JAN 18 2006”) receipt card (see: MPEP § 503³) indicating receipt

³ MPEP § 503 provides in pertinent part:
§ 503 Application Number and Filing Receipt

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 C.F.R. § 1.53(a)).

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new

by the Office of a paper that Petitioner called “Response to Notice of Non-Compliant Amendment”;

- notably, in response to Petitioner’s filing of an unlabeled and un-annotated drawing accompanying Petitioner’s 19 December, 2005, amendment, the Office Noticed the Petitioner that the drawing required some designation to be a proper figure;
- rather than provide the designation(s) requested by the Office, the Petitioner chose instead to lecture the Examiner, to wit:

...as could easily have been ascertained if Applicant’s Response had been actually (sic) read, it would have been readily apparent that the attached drawing is not intended as an application drawing, but is merely an exhibit used to explain and illustrate Applicant’s arguments in support of patentability. This could easily have been ascertained by a very quick review of Applicant’s response, wherein no drawing amendment whatsoever was indicated.

There is no need to designate the drawing as a replacement sheet⁴

Notably, Petitioner located the entitlement of his 18 January, 2006, paper (“Response to Notice of Non-Compliant Amendment”) not between Petitioner’s designation of addressee (“Mail Stop Amendment”) and Petitioner’s argument, where the purpose of the paper might be apparent to filing and docketing personnel (who may not possess Petitioner’s extensive prosecution and scientific training, expertise and experience—but, rather, Petitioner chose to integrate the entitlement into the very caption of the paper, and

application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard “a complete application” or “patent application” will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the post-card initialed by the person receiving the items. Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO. (Emphasis supplied.)

⁴ Petitioner’s 18 January, 2006, filing, at pages 1 and 2.

so it was identified in Office records not as Petitioner's response to an Office action but as a "Miscellaneous Incoming Letter";

- apparently frustrated that the Office had missed the presence of his 18 January, 2006, paper—and so issued the 8 September, 2006, Notice of Abandonment—Petitioner first educated the Office as to the (one-day) date inaccuracy (i.e., the indication in the Notice that the mail date of the Notice of Non-Compliant Amendment was not 29 but rather 30 December, 2005) of the Notice of Abandonment, and Petitioner continued that he “assumes that this was the communication for which allegedly no response was received at the Patent and Trademark Office”—and Petitioner continues” “On January 16, 2006, Applicant did file a Response to Notice of Non-Compliant Amendment”;
- as one long registered to practice before the Office, Petitioner, of course, is aware of his error in this latter statement because, while Petitioner may aver that he executed on 16 January, 2006, a Certificate of Mailing (under 37 C.F.R. §1.8) on the Response to the Notice of Non-Compliant Amendment, that execution was little more than a statement that Petitioner had on that date sent the paper to be mailed—i.e., submitted the paper, as Petitioner is aware is the proper expression in practice before the Office—and not filed it at all because in the absence of a transmission under the provisions of 37 C.F.R. §1.10 there is no filing of papers via the U.S. Postal Service (USPS) until they are physically received at the Office;
- Petitioner continued his averments in the 9 November, 2006, petition by again taking up his lecture to the Office—and asserted that:

... the original Notice of Non-Compliant Amendment was erroneously sent *** [and] *** stated that the drawing attached to the Response filed on December 19, 2005, were not identified as “Replacement Sheet” *** [but] *** as could easily have been ascertained, if Applicant's Response had actually been read, the drawing attached *** was not intended as an application drawing, but was an Exhibit⁵

Petitioner, of course, recognizes his own error here as well, because the 30 December, 2005, Notice of Non-Compliant Amendment from the Office did not designate Petitioner's drawing as a “Replacement Sheet,” but, rather, directed Petitioner to label properly the drawing as would be informative to the Examiner and responsive to the Notice and the Rules of Practice (37 C.F.R. Part 1).

⁵ Petitioner's 9 November, 2006, filing, at page 2.

Thus, Petitioner argues both that he did not receive the Office action—because the Office action identified in the Notice of Abandonment is one of 29 December, 2005, and, as noted above, the mail date actually was 30 December, 2005—and that in any case he timely and properly filed a reply in the form of the 18 January, 2006, paper.

Petitioner is correct in part: the 8 September, 2006, Notice of Abandonment appears to have been mailed improvidently because Petitioner timely filed a reply on 18 January, 2006—however, the determination as to whether that reply was proper or not is one which will remain within the purview of the Examiner following the mailing of this decision.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)); and those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.⁶

⁶ See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁷

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁸

Delays in responding properly raise the question whether delays are unavoidable.⁹ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).¹⁰

And the Petitioner must be diligent in attending to the matter.¹¹ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and

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- (1) Holding certain facts to have been established;
 - (2) Returning papers;
 - (3) Precluding a party from filing a paper, or presenting or contesting an issue;
 - (4) Imposing a monetary sanction;
 - (5) Requiring a terminal disclaimer for the period of the delay; or
 - (6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

⁷ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁸ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁹ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

¹⁰ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

¹¹ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.¹²⁾⁾

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.¹³

The commentary at MPEP §711.03(c) provides:

* * *

**A. Petition To Withdraw Holding of Abandonment Based on Failure To
Receive Office Action**

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

¹² Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

¹³ See: *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

* * *

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988). (Emphasis supplied.)

* * *

The commentary at MPEP §711.03(c) further provides:

* * *

B. Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed

37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as “Express Mail.” A petition to withdraw the holding of abandonment relying upon a timely reply placed in “Express Mail” must include an appropriate petition under 37 C.F.R. §1.10(c), (d), * (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the “Express Mail” procedures, the paper must be entered in PALM with the “Express Mail” date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is

shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.

* * *

And the regulation requires that relief be sought within two (2) months of the act complained of.

Petitioner appears technically to have satisfied the showing requirement described above.

CONCLUSION


Because Petitioner technically appears to have carried his burden in the instant matter, the petition as considered under 37 C.F.R. §1.181 is **granted**, and the 8 September, 2006, Notice of Abandonment is **vacated**; further:

- the Examiner's attention is drawn as well to the provisions of 37 C.F. R. § 1.3;

- the Examiner may now make a determination whether Petitioner's 18 January, 2006, reply is or is not consistent with those regulatory provisions; and
- having made such a determination, the Examiner may act to enter or not the reply, and, if appropriate, provide Notice of non-entry consistent with the regulations at 37 C.F. R. § 1.3.

The application is released to Technology Center 2800 for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2¹⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



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Office of Petitions

¹⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.